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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,007	04/20/2000	Donald R. Ricci	1960.166CIP	6249

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CHICAGO, IL 60661-3693

EXAMINER

THANH, LOAN H

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 06/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/557,007

Applicant(s)

RICCI, DONALD R.

Examiner

LoAn H. Thanh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 9-11, 16-18, 24-26, 31-33, 39-41, 46-57 and 59 is/are pending in the application.
- 4a) Of the above claim(s) 50 and 53 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-11, 16-18, 24-26 and 31-333 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

The drawing objection is maintained. The carious densities of the tube could be shown with "hatched" markings. However, new proposed drawings must be drawn so as not to introduce new matter.

The claim objections have been withdrawn in view of the amendment filed 03/30/04.

The double patenting rejection has been obviated in view of the terminal disclaimer has been accepted as filed on 03/30/04.

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, various densities of the tube ( cl. 51) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Gharibadeh et al. ( U.S. Patent No. 5,458,613).

Gharibadeh et al. discloses a balloon catheter with an opening and slit-forming region disposed longitudinally in the tubular member. For a guidewire ( 30 or 31) to be separated from the second lumen. Slit forming region can be considered as 17 or 26 where applicable. Further an adapter slit in the adapter region at the proximal portion of the device. See figures 1-7. With respect to the lumens being disposed in a substantially solid lumen, applicant is requested to look at figures 3-7. In as much as applicant has claimed the substantially solid tubular member, Gharibadeh et al. has also shown.

### ***Claim Rejections - 35 USC§ 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-18,24-26 are rejected under 35 U.S.C. 103 as being unpatentable over Gharibadeh et al. ( U.S. Patent No.5,458,613) .

Gharibadeh et al. discloses the invention substantially as claimed. See above. However, Gharibadeh et al. does not disclose a guide catheter. It is common knowledge

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in the prior art to utilize a guide catheter with a balloon catheter in the analogous art of balloon catheters for the purpose of aiding in the placement of the balloon catheter by using a delivery sheath. Further, it does not appear that this feature of a guide catheter would make the claim patentable.

Claims 31-33,39-41,46-49,52, 54-57,59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gharibadeh et al. (U.S. Patent No. 5,458,613) in view of Barry (U.S. 5,685,847).

Gharibadeh et al. disclose the invention substantially as claimed. Gharibadeh et al. disclose a tubular member (11), an inflatable balloon (13), a first lumen (12), a second lumen (14 and/or 20) and a guidewire (30 and/or 31). Gharibadeh et al. show a slit (24,26) and an adapter (having a first and second arm (33,35)). The adapter slit is considered to be either the insert slit (39) or the adapter slit (38). Upon closer examination of the reference, Gharibadeh et al. disclosed (6:60-710) that the adapter (33,35) has a straight slit (38) along the entire length from the proximal to the distal end of the adapter. As to the limitation that the adapter slit is narrower than the guidewire diameter throughout the length of the adapter, the Examiner is directing applicant to fig. 2 and more specifically to fig. 3. Fig. 3 clearly shows the slit to be narrower than the guidewire and fig. 2 clearly shows the adapter slit to be throughout the length of the adapter (along 35). Gharibadeh et al. however does not teach a stent mounted on the balloon. Barry teaches a balloon catheter for deploying a stent. It is well known in the art to use balloon catheters to deliver stents. Thus, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to modify the balloon catheter of Gharibadeh et al. as taught by Barry in order to deploy stents.

With respect to claims 46, 47, 56, the straight slit is considered to be shown in figure 2. The adapter being 35 with the straight slit.

Claim 51 is rejected under 35 U.S.C. 103 as being unpatentable over Gharibadeh et al. ( U.S. Patent No.5,458,613) .

Gharibadeh et al. discloses the invention substantially as claimed. See above. However, Gharibadeh et al. does not disclose various densities in the tube. It is common knowledge in the prior art to vary the densities of the tube in order to better maneuver the catheter through the winding paths of the body vessels. Further, it does not appear that this feature of a guide catheter would make the claim patentable.

### ***Response to Arguments***

Applicant's arguments filed 03/30/04 have been fully considered but they are not persuasive. Applicant's arguments that the claimed ( amended) adapter slit is "straight from a proximal end of the catheter to the distal end of the adapter" has not overcome the art of record ( Gharibadeh et al.). The slit of Gharibadeh et al. is straight at the proximal end of the catheter to the distal end of the adapter.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Johnson et al. (U.S. Patent No.5290232) further supports a balloon catheter having a straight adapter slit for removal of the guidewire.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LoAn H. Thanh whose telephone number is (703) 305-0038. The examiner can normally be reached on Mon. - Fri. (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LoAn H. Thanh  
Primary Examiner  
Art Unit 3763

LT